

Serial No. 09/922,066  
Filed: August 3, 2001

### **REMARKS**

Applicants wish to thank Examiners Patel and Raymond for the courtesy shown their representative during the personal interview conducted October 30, 2003. With entry of the present amendment, claims 1 to 6, 8, 9, 35, 39, 40, 42, 44, 45, 52, 69, and 78 to 80 are pending. Claims 1 to 6, 8, 9, 35, 39, 44, 52, and 69 have been amended. Claims 7, 10 to 34, 36 to 38, 41, 43, 46 to 51, 53 to 68, and 70 to 77 have been cancelled, and new claims 78 to 80 added.

Support for the amendments can be found in the specification and claims as originally filed. As discussed in the interview, the amendments have been made to bring the scope of the claims more in line with the Examiner's restriction requirement. New claims 78 to 80 are directed to specific species encompassed by the generic claim and are the species of examples 41, 42, and 49. With the exception of the minor language amendments noted in response to the rejection under 35 U.S.C. § 112, second paragraph, below, the amendments were not made for reasons of patentability, but with regard to the restriction requirement previously issued in the application. No new matter has been added by these amendments.

The Director is hereby authorized to charge Deposit Account No. 08-2525 in the amounts of \$770 to cover the fees for a Request for Continued Examination and \$110 to cover the fee for the one-month extension of time. No additional fees are believed due. However, the Director is hereby authorized to charge any deficit, or credit any overpayment, to Deposit Account No. 08-2525.

### **OBJECTION OF CLAIMS 71 TO 77 AS CONTAINING NEW MATTER**

Claims 71 to 77 were added in the amendment filed August 20, 2003. These claims have been objected to as containing new matter on the basis that the claims contain information not included in the European Priority Document EP 00117003.

Applicants respectfully traverse this rejection for the following reasons. It is improper to base a new matter rejection upon subject matter which is present or absent from any document other than the U.S. application under examination. The issue is not whether claims 71 to 77 are supported by the priority document, but whether they are supported by the specification of the instant application as filed. Applicants submit that claims 71 to 77 are supported by the specification as filed.

In response to the interview conducted October 30, 2003, Applicants have canceled claims 71 to 77 in an attempt to amend the pending claims in accordance with the restriction requirement previously issued in the application. As these claims have been canceled, the rejection is moot.

**REJECTION OF CLAIMS 1, 2, 4, 35, AND 71 TO 77 UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

Claims 1, 2, 4, 35, and 71 to 77 have been rejected under 35 U.S.C. § 112, second paragraph, as indefinite. In particular, it is alleged that the terms aromatic heterocycle, and non-aromatic heterocycle are indefinite because the claims do not define the exact number of rings or heteroatoms and the exact points of attachment to the carbon atom of the core. In addition, the Office Action states that the term "aryl" is not acceptable. Further, the terms "containing" and "comprising" have been rejected in claims 1, 2, 4, 35, 71, 72, 73, and 76 as creating unacceptable open language.

Applicants respectfully traverse this rejection for the following reasons. Determination of definiteness of claim language must be analyzed in light of (a) the content of the particular application disclosure; (b) the teachings of the prior art; and (c) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

With regard to the terms aromatic heterocycle and non-aromatic heterocycle, Applicants note that the terms actually used in the claims are a “five or six membered aromatic heterocycle containing one to four heteroatoms selected from N, O or S” and a “five or six membered non-aromatic heterocycle.” The term “five or six membered aromatic heterocycle containing one to four heteroatoms selected from N, O or S” specifically states the number of ring members, the number of heteroatoms, and the type of heteroatoms in the ring. Further, examples of the groups encompassed by this definition are provided in paragraph [0015] of the specification which states that “the term ‘five or six membered aromatic heterocycle, containing one to four heteroatoms, selected from N, O or S’ denotes, for example, the following groups: pyrrol-1-yl, imidazol-1 or 2-yl, pyrazol-1-yl, pyridine-2, 3 or 4-yl, pyrazinyl, pyrimidinyl, pyridazinyl, isothiazolyl, isoxazolyl, thienyl, 1,2,3-triazolyl, 1,2,4-oxadiazolyl, tetrahydro-pyridinyl, isoxazolyl, or furyl.” Similarly, the term five or six membered non-aromatic heterocycle is defined in paragraph [0016] of the specification as a “five or six membered non-aromatic heterocycle having at least one nitrogen atom or one nitrogen atom and a second heteroatom selected from the group nitrogen, sulfur and oxygen.” The specification further recites examples of such groups as pyrrolidinyl, imidazolidinyl, pyrazolidinyl, piperidinyl, piperazinyl, morpholinyl, thiomorpholinyl, thiomorpholin-1,1-dioxo or thiomorpholinyl-1-oxo. Applicants submit that one having ordinary skill in the art would understand the scope of the claims on the basis of these definitions.

Applicants respectfully submit that the term “aryl” is defined in paragraph [0017] of the specification as a monocyclic aromatic hydrocarbon radical or a bicyclic or tricyclic ring system in which at least one ring is aromatic. Examples of such groups as phenyl, benzyl and naphthyl also are provided in the specification. *In re Sus* and *In re Lund*, cited in the Office Action are distinguished from the instant application because in those cases, no definition of the term “aryl” was provided in the specification.

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With regard to the terms “containing” and “comprising” in the claims, Applicants have amended claims 1, 2, 5, 6, 39, 44, and 69 to remove the confusing language.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of this rejection.

**COMMENTS REGARDING PRIORITY OF THE APPLICATION**

The office action maintains denial of Applicants’ claim of priority on the basis that the claims do not recite the same subject matter as claimed in EPO 00117003, filed August 8, 2000.

Applicants respectfully traverse denial of their claim for priority for the following reasons. First, as noted in the last response, the only times during *ex parte* prosecution that applicants’ claim of priority is to be considered on the merits is when a reference is found with an effective date between the date of the foreign filing and the date of filing in the United States and when an interference is under consideration (M.P.E.P. § 201.15). No intervening reference has been cited in the Office Action, and there is no indication that an interference is under consideration.

Second, as noted in the M.P.E.P., a U.S. application may be entitled to the filing date of a foreign application with respect to some claims and not with respect to others (*See* M.P.E.P. § 201.15). Applicants have amended the claims in response to the restriction requirement issued earlier during prosecution of the application. A review of the currently pending claims indicates that each and every element of the claims is encompassed by the disclosure of the priority document. Therefore, Applicants submit that the instant claims are entitled to priority of EPO 00117003.

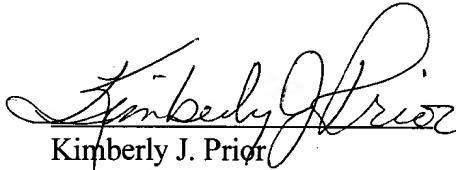
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For at least these reasons, applicants respectfully request reconsideration and granting of applicants' claim for priority.

The foregoing amendment is fully responsive to the Office Action issued September 17, 2003. Applicants submit that Claims 1 to 6, 8, 9, 35, 39, 40, 42, 44, 45, 52, 69, and 78 to 80 are allowable. Early and favorable consideration is earnestly solicited.

If the Examiner believes there are other issues that can be resolved by telephone interview, or that there are any informalities remaining in the application which may be corrected by Examiner's Amendment, a telephone call to the undersigned attorney is respectfully solicited.

Respectfully submitted,

A handwritten signature in cursive script, reading "Kimberly J. Prior".

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